

REMARKS/ARGUMENTS

Claims 1-27 were presented for examination and were rejected. Applicant is hereby amending claims 1-6, 9-14, 16-21 and 23. Support for all claim amendments is found in the application as originally filed. Reconsideration of this application as amended, and allowance of all claims remaining herein, claims 1-27 as amended, are hereby respectfully requested.

EXAMINER'S OBJECTION TO FIGURE 5

In section 3 of the Office Action, the Examiner objected to Figure 5 of Applicant's specification stating Figure 5 failed to comply with 37 C.F.R. 1.84(p)(5), because the figure includes a reference to element 15, not mentioned in the description.

Applicant is hereby amending the paragraph beginning at line 10 of page 13 to include a reference to element 15. As amended, the specification meets the requirements of 37 C.F.R. 1.84(p)(5).

For the above reason, the Examiner is requested to withdraw his objection to Figure 5.

EXAMINER'S REJECTION OF CLAIMS 1-27 UNDER 35 U.S.C. § 112

In the Office Action, the Examiner rejected claims 1-27 under 35 U.S.C. § 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention.

With respect to claim 1, the Examiner stated that it is unclear whether the term "attributes" as used in lines 10 and 17 of claim 1 is intended to be the same as the term "file attributes" as used in line 2 of claim 1. Applicant is hereby amending claim 1, as

well as claims 2-5, 9-13, 16-20 and 23, such that the term "attributes" now reads "file attributes." As amended, claims 1-5, 9-13, 16-20 and 23 particularly point out and distinctly claim the subject matter which the Applicant regards as the invention.

With respect to claims 2-3, the Examiner stated that it is unclear whether the term "a specific file" as used in lines 2 and 3 of claims 2 and 3 is intended to be the same as the term "a specific file" as used in line 19 of claim 1. Applicant is hereby amending the phrase "a specific file" to read, "the specific file." Accordingly, as used in claims 2 and 3, the term "the specific file" refers to the same "specific file" that is referenced in claim 1. As amended, claims 2-3 particularly point out and distinctly claim the subject matter which the Applicant regards as the invention.

With respect to claim 4, the Examiner stated that it is unclear whether the term "attributes" as used in line 2 of claim 4 is intended to be the same as the term "file attributes" as used in line 2 of claim 1. As described above in connection with the amendment made to claim 1, claim 4 is hereby being amended such that "attributes" is now "file attributes." Therefore, as amended, claim 4 particularly points out and distinctly claims the subject matter which the Applicant regards as the invention.

Referring again to claim 4, the Examiner has stated that it is unclear whether the term "a record in the database" in line 3 is intended to refer to the same "record in the database" referenced in line 18 of claim 1. Applicant points out that, as used in claim 4, the phrase "being stored as a record in the database" is modifying "specific file attributes." For example, the "specific file attributes" are those file attributes that are "being stored as a record in the database." If Applicant intended for the "record" referred to in claim 4 to be the same "record" referred to in claim 1, the term "record" in claim 4 would be preceded by the article "the." Therefore, it is clear that the "record" referenced in claim 4 need not be the same as the specific "record" referred to in claim

1. Therefore, Applicant submits that claim 4 particularly points out and distinctly claims the subject matter which the Applicant regards as the invention.

Referring again to claim 4, the Examiner stated that it is unclear whether the term "a specific file" as used in line 4 of claim 4 is intended to be the same "specific file" referred to in line 19 of claim 1. Applicant points out that the phrase "concerning a specific file" is modifying the "specific file attributes." For example, the "specific file attributes" are those file attributes that are "concerning (e.g., related to) a specific file." As such, the specific file referenced in claim 4 need not be the same as the specific file referenced in claim 1. If Applicant intended otherwise, the article preceding the phrase "specific file" in claim 4 would be "the" and not "a." Therefore, Applicant submits that claim 4 particularly points out and distinctly claims the subject matter which the Applicant regards as the invention.

In addition, the Examiner stated that claims 5-27 included deficiencies similar to those found in claims 1-4. Accordingly, Applicant is hereby amending claims 5, 9-13, 16-20 and 23 to correct all such deficiencies. For the above reasons, the Examiner is requested to withdraw his rejection of claims 1-27 under 35 U.S.C. § 112; and to allow these claims as amended.

EXAMINER'S REJECTION OF CLAIMS 9-15 UNDER 35 U.S.C. § 101

In the Office Action, the Examiner rejected claims 9-15 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Specifically, the Examiner stated that claims 9-15 are "software, per se, and therefore [are directed to] non-statutory subject matter."

Applicant traverses this rejection. Claims 9-15 are directed to "**a computer readable medium**" containing a computer program product for gleaning file attributes ... the computer program product comprising program code for: receiving ... scanning ...

gleaning ... storing ... and indexing.” As such, the program code is embodied in a computer readable medium. The claimed computer readable medium is a tangible element that enables a computer to perform the claimed functions. Accordingly, the claims are directed to statutory subject matter.

Applicant directs the Examiner to the discussion on Functional Descriptive Material at Section (IV)(1)(a) of the Examination Guidelines for Computer Related Inventions, reproduced in the MPEP at Section 2106, which states:

Similarly, computer programs claimed as computer listings *per se*, i.e., the descriptions or expressions of the programs, are not physical “things.” They are neither computer components nor statutory processes, as they are not “acts” being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program’s functionality to be realized. In contrast, **a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program’s functionality to be realized, and is thus statutory.** Accordingly, it is important to distinguish claims that define descriptive material *per se* from claims that define statutory inventions.

For the above reasons, the Examiner is requested to withdraw his rejection of claims 9-15 under 35 U.S.C. § 101; and to allow these claims as amended.

EXAMINER’S REJECTION OF CLAIMS 1-3, 6, 8-11, 14, 16-18 AND 21 UNDER 35 U.S.C. § 102(b)

In section 13 of the Office Action, the Examiner rejected claims 1-3, 6, 8-11, 14, 16-18 and 21 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,495,607 to Pisello et al. (hereinafter, “Pisello”). Of these claims, claims 1, 9 and 16 are independent claims.

Pisello generally relates to “[a] network management system includ[ing] a domain administrating server (DAS) that stores a virtual catalog representing an overview of all files distributively stored across a network domain.” (Pisello, Abstract). Accordingly, the network management system provides a mechanism for monitoring and tracking the location, within a domain or network, of various files.

Independent claim 1 is patentably distinct over Pisello as claim 1 recites, “a non-application specific file attribute manager receiving a plurality of files in a plurality of formats; ... scanning the plurality of received files in the plurality of formats; [and] gleaning file attributes concerning each of the plurality of scanned files.” Accordingly, the file attribute manager 1) receives files, 2) scans the files, and 3) gleans file attributes from the files. In contrast, Pisello refers to a data management program that queries other file-servers for previously cataloged information about files. For example, Pisello states:

A domain-wide status-monitor and control program **150.2** is installed in the domain administrating server 150. One of the domain-wide status monitoring functions of program **150.2** is to: (1) periodically scan the domain **190** and interrogate each DAS-managed file-server **110, 120, ..., 140** regarding the contents of each local catalog **111.0, 112.0, ..., 144.0** that is associated with each of data storage device **111, 112, ..., 144** in the network domain **190**; (2) to collect the file identifying information stored at a given scan time in each such local catalog by way of the network-linking backbone **105**, and (3) to integrate the collected information into the domain-wide virtual catalog **150.00** so that each user file stored in the domain **190** during a given scan-period can be identified by time-of-scan, file-name, path location or other relevant attributes simply by consulting the domain wide virtual catalog **150.00**. (Pisello, Col. 13, Lines 14-55).

First, according to Pisello, the domain-wide status-monitor scans, or queries, the pre-existing local catalog of another computer to collect file identifying information (not files). Therefore, in contrast to the file attribute manager of claim 1, the domain-wide status monitor of Pisello does not receive a plurality of files in a plurality of formats.

Furthermore, the domain-wide status monitor of Pisello scans an existing local catalog of another computer. Pisello does not suggest or disclose scanning a plurality of received files in a plurality of formats. Finally, as the domain-wide status-monitor of Pisello does not receive or scan files, it would be impossible for the domain-wide status-monitor to glean file attributes from the received files. Stated differently, Pisello does not disclose or suggest, "receiving a plurality of files in a plurality of formats ... scanning the plurality of received files ... [and] gleaning file attributes concerning each of the plurality of scanned files," as is recited in claim 1.

Independent claims 9 and 16 include limitations similar to those in claim 1. For example, independent claim 9 is directed to "[a] computer readable medium ... comprising program code for: receiving a plurality of files in a plurality of formats; scanning the plurality of received files in the plurality of formats; [and] gleaning file attributes concerning each of the plurality of scanned files in the plurality of formats." Claim 16 includes similar limitations.

Dependent claims 2-3, 6, 8, 10-11, 14, 17-18 and 21 are dependent upon claims 1, 9 and 16. Accordingly, the patentability of these dependent claims flows from the patentability of independent claims 1, 9 and 16.

For at least the reasons stated above, claims 1-3, 6, 8-11, 14, 16-18 and 21 are not anticipated by Pisello. Accordingly, the Examiner is respectfully requested to withdraw his rejection of claims 1-3, 6, 8-11, 14, 16-18 and 21; and to allow the claims as amended.

EXAMINER'S REJECTION OF CLAIMS 4, 12 AND 19 UNDER 35 U.S.C. § 103(a)

In Section 20 of the Office Action, the Examiner rejected dependent claims 4, 12 and 19 under 35 U.S.C. § 103(a) as being obvious in view of the combination of Pisello and U.S. Patent No. 5,694,569 to Fischer (hereinafter, "Fischer").

As dependent claims 4, 12 and 19 are dependent upon independent claims 1, 9 and 16, respectively, the patentability of these dependent claims flows from the patentability of independent claims 1, 9, and 16. The Examiner has not cited Fischer to show the features recited in the independent claims that Pisello lacks, but instead to show additional, dependently claimed features. Thus, Applicant submits that dependent claims 4, 12 and 19 are allowable over a hypothetical combination of Pisello and Fischer for at least the same reasons that their parent claims are allowable over Pisello. The Examiner is respectfully requested to withdraw his rejection of dependent claims 4, 12 and 19; and to allow the claims.

EXAMINER'S REJECTION OF CLAIMS 5, 13, AND 20 UNDER 35 U.S.C. § 103(a)

In Section 22 of the Office Action, the Examiner rejected dependent claims 7, 15 and 22 under 35 U.S.C. § 103(a) as being obvious in view of the combination of Pisello and U.S. Patent Publication No. 2003/0233352 to Baker (hereinafter, "Baker").

As dependent claims 5, 13 and 20 are dependent upon independent claims 1, 9 and 16, respectively, the patentability of these dependent claims flows from the patentability of independent claims 1, 9, and 16. The Examiner has not cited Baker to show the features recited in the independent claims that Pisello lacks, but instead to show additional, dependently claimed features. Thus, Applicant submits that dependent claims 5, 13 and 20 are allowable over a hypothetical combination of Pisello and Baker for at least the same reasons that their parent claims are allowable over Pisello. The Examiner is respectfully requested to withdraw his rejection of dependent claims 5, 13 and 20; and to allow the claims.

EXAMINER'S REJECTION OF CLAIMS 7, 15 AND 22 UNDER 35 U.S.C. § 103(a)

In Section 24 of the Office Action, the Examiner rejected dependent claims 7, 15 and 22 under 35 U.S.C. § 103(a) as being obvious in view of the combination of Pisello and U.S. Patent Publication No. 2002/0046207 to Chino et al. (hereinafter, "Chino").

As dependent claims 7, 15 and 22 are dependent upon independent claims 1, 9 and 16, respectively, the patentability of these dependent claims flows from the patentability of independent claims 1, 9, and 16. The Examiner has not cited Chino to show the features recited in the independent claims that Pisello lacks, but instead to show additional, dependently claimed features. Thus, Applicant submits that dependent claims 7, 15 and 22 are allowable over a hypothetical combination of Pisello and Chino for at least the same reasons that their parent claims are allowable over Pisello. The Examiner is respectfully requested to withdraw his rejection of dependent claims 7, 15 and 22; and to allow the claims.

EXAMINER'S REJECTION OF CLAIMS 23-27 UNDER 35 U.S.C. § 103(a)

In Section 26 of the Office Action, the Examiner rejected dependent claims 23-27 under 35 U.S.C. § 103(a) as being obvious in view of the combination of Pisello and U.S. Patent No. 6,092,194 to Touboul (hereinafter, "Touboul").

As dependent claims 23-27 are dependent upon independent claim 1, the patentability of these dependent claims flows from the patentability of independent claim 1. The Examiner has not cited Touboul to show the features recited in the independent claims that Pisello lacks, but instead to show additional, dependently claimed features. Thus, Applicant submits that dependent claims 7, 15 and 22 are allowable over a hypothetical combination of Pisello and Touboul for at least the same reasons that their parent claims are allowable over Pisello. The Examiner is respectfully requested to withdraw his rejection of dependent claims 23-27; and to allow the claims.

Applicant believes that this application is now in condition for allowance of all claims herein, claims 1-27, and therefore an early Notice of Allowance is respectfully requested. If the Examiner disagrees or believes that, for any other reason, direct contact with Applicant's attorney would help advance the prosecution of this case to finality, the Examiner is invited to telephone the undersigned at the number given below.

The Commissioner is hereby authorized to credit overpayments or to charge any deficiency in a required fee to Deposit Account No. 19-3140. A duplicate copy of this sheet is enclosed. **A duplicate copy of this Notice is enclosed for this purpose.**

Respectfully submitted,

A handwritten signature in black ink that reads "Nathan Elder". The signature is fluid and cursive, with the first name "Nathan" and last name "Elder" clearly distinguishable.

Nathan Elder
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